REMARKS/ARGUMENTS

Claims 1-26 are pending and at issue in the present application.

Applicants traverse the rejections of claims 1-9, 11-22, and 24-26 as obvious over Simpson in view of Hohensee et al. Applicants further traverse the rejections of claims 10 and 23 as obvious over Simpson in view of Hohensee et al., Cohen et al., and Mastie.

Claim 1, and claims 2-15 dependent directly or indirectly thereon, recite a software system for generating a second page description file from a first page description file. The software system comprises a first routine for generating a template, a second routine for extraction of data from the first page description file to generate a database for storing the extracted data, and a third routine for generating a second page description file from the template and the database. The first page description file includes at least layout information for at least one page.

Claim 16, and claims 17-26 dependent directly or indirectly thereon, recite a method of generating a second page description file from a first page description file including the steps of generating a template, extracting data from the first page description file in an automated fashion to generate a database for storing the extracted data, and generating a second page description file from the template and the database. The first page description file includes content and layout information for at least one page.

None of the cited references teaches or suggests a software system for or method of generating a second page description file from a first page description file including a routine for or the steps of extracting data from a first page description file to generate a database, wherein the first page description file includes at least layout information, or both content and layout information, as specified by the claims at issue.

In fact, Simpson discloses using Wordperfect® for converting an ASCII comma-delimited text file representing a database into a Wordperfect® formatted secondary merge file, which also represents the database and has field names and records to be used by Wordperfect®. A primary merge file is created in Wordperfect®, wherein the primary merge file includes static information and field names. When a merge is performed, variable data from the secondary merge file is inserted into the field names of the primary merge file for each record, thus creating a customized document for each record. The secondary merge file

described in Simpson is not a page description file, because it does not comprise content and layout information for one or more pages to be printed, displayed, or otherwise reproduced.

Hohensee et al. discloses the conversion of files from Portable Document Format (PDF) to Mixed Object Document Content Architecture (MO:DCA®) format. The two file formats generate identical output pages, but the conversion of PDF to MO:DCA® is intended to reduce redundant information that is sent to a printer and to minimize recovery time due to print errors. In order to generate the identical output pages, the data contained in the PDF file are stored in a database and reassembled into the corresponding MO:DCA® file.

Applicants contend that it is not appropriate to combine Simpson and Hohensee et al. to reject the claims at issue. A person of ordinary skill in the art would not have looked to the teachings of Hohensee et al. to modify Simpson, because Simpson relates to a system of merging a template with a database to create documents containing variable information, and Hohensee et al. relates to a file format conversion system for generating identical output pages. In addition, the merge feature of Simpson generates a variable page from a template and a database and is only responsive to a database that is entered by a user in comma-delimited text file format. Accordingly, the merge feature of Simpson is not responsive to files containing layout information; in particular, the secondary merge file of Simpson could not be generated from a file in PDF format. Therefore, any attempt to combine the features of Simpson and Hohensee et al. would result in a system that would be inoperative, and hence, for this reason as well, it would not have been obvious to combine Simpson and Hohensee et al. in order to arrive at the subject matter recited by the claims at issue.

Cohen et al. discloses a document generation and delivery system that stores a number of pre-defined overlays, wherein each overlay includes a plurality of data fields. A set of instructions is generated to define the location of each data field within the overlay. Input data received in the form of character strings identify the overlay to be used and provide specific data for insertion into the defined data fields within the selected overlay in accordance with the associated set of instructions.

Mastie discloses a method and apparatus for assembling a set of input page files in the correct sequence to generate a single output file in the form of a digital book. Importantly, neither Cohen et al. nor Mastie supply the deficiencies noted above with respect to Simpson and Hohensee et al.

Furthermore, because none of the cited references discloses or suggests that it would have been desirable or even possible to extract data from a first page description file to generate a database for storing the extracted data, wherein the first page description file includes at least layout information, or both content and layout information, or to provide a routine that accomplishes this function, as specified by claims 1-26, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the rejection of the claims at issue should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and reconsideration thereof are respectfully requested.

Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

McCracken & Frank LLP
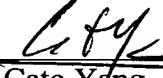
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